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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,786	01/13/2000	Bruce L. Davis	60086	7463

23735 7590 02/23/2004

DIGIMARC CORPORATION
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EXAMINER

CHOOBIN, BARRY

ART UNIT PAPER NUMBER

2625

DATE MAILED: 02/23/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/482,786

Applicant(s)

DAVIS ET AL.

Examiner

Barry Choobin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-23,34-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 10, 2003 regarding claims 15-23, 34-37 have been fully considered but they are not persuasive.
2. As to claim 15, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "carrying a reference auxiliary data".) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to claim 20, applicant argues that prior art fails to disclose or teach: "each item being associated with an image via a reference steganographically encoded in the image".

The Examiner disagrees. Balogh et al disclose "images are retrieved by association metadata with an image" corresponding to "each item being associated with an image via a reference steganographically encoded in the image" as required by claim 20.

As to claims 34 and 35, Applicant argues that prior art fails to disclose: "a history file detailing vendors from whom a consumer has requested service relating to an image"

The Examiner disagrees. Balogh et al discloses a history file at column 17, lines 34-37).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 15-23 and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Balogh et al (US Patent 5,493,677).

As to claim 15, Balogh et al disclose a method for associating auxiliary data with an image, the method comprising (column 1, lines 55-64): extracting a steganographic reference to auxiliary data in the image (column 8, line 64 through column 9, line 14); querying a metadata database to request the auxiliary data associated with the image using the extracted reference to access the auxiliary data in the metadata database (column 8, line 64 through column 9, line 14); and receiving the auxiliary data from the database (column 1, lines 56-64).

As to claim 16, Balogh et al disclose using the auxiliary data received from the database to create an image file including the image and the auxiliary data (column 4, lines 15-33).

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As to claim 17, Balogh et al disclose sending authentication data to the metadata database to request access to the auxiliary data associated with the image (column 9, lines 15-34).

As to claim 18, Balogh et al disclose sending a request to the metadata database to edit the auxiliary data associated with the image (column 10, lines 50-65).

As to claims 19 and 23, Balogh et al disclose a computer readable medium having software for performing the method of claim 15 (column 3, lines 60-66).

As to claim 20, Balogh et al disclose a method for associating auxiliary data with an image (column 1, lines 55-64), the method comprising: maintaining a database of auxiliary data items associated with images (see claim 15), each item being associated with an image via a reference steganographically encoded in the image (column 12, lines 8-33); from a requesting application, receiving a request for auxiliary data associated with an image (see claim 15), the request including a reference extracted from the image; using the reference to locate the auxiliary data associated with the image in the database (column 5, lines 5-26); and returning the auxiliary data corresponding to the reference to the requesting application (column 18, lines 46-55).

As to claim 21, Balogh et al disclose determining whether the requesting application has access rights to the requested auxiliary data (column 17, lines 38-45).

As to claim 22, Balogh et al disclose determining whether the requesting application has editing rights for the requested auxiliary data (column 16, lines 40-62).

As to claim 34, Balogh et al disclose an image database accessible on the internet, permitting storage of images from plural unrelated consumers, characterized in

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that the database maintains - for each of several images - a history file detailing the vendors from whom a consumer has requested service relating to an image (1, lines 48-52).

As to claim 35, Balogh et al disclose a method of maintaining a transaction history for image processing transactions on images (column 4, lines 35-47), the method comprising: maintaining a transaction history of an image stored on a networked device (see claim 15); in response to receiving a transaction request to process an image stored on the networked device, updating the transaction history of the image by adding data about the transaction to the transaction history (see claim 15).

Claims 36 and 37 are similarly analyzed and rejected.

Allowable Subject Matter

5. Claims 24-25 are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Choobin whose telephone number is 703-306-5787. The examiner can normally be reached on M-F 7:30 AM to 18:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703-308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Barry choobin

February 13, 2004


BHAVESH M. MEHTA
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